

REMARKS

Claims 1, 3, 5, 9, 11, 15, 17 and 20 are pending in the application. Claim 1 has been amended and claims 4 and 7 have been canceled by way of the present amendment. Favorable reconsideration of the application is requested.

In the outstanding Office Action, issued November 1, 2006, claims 1, 3-5, 7, 9, 11, 15, 17 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2001/0051987 (Fukumoto et al.) in view of U.S. Patent No. 6,301,608 (Rochkind).

U.S.C. Section 103 Rejections

Claims 1, 3-5, 7, 9, 11, 15, 17 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumoto et al. in view of Rochkind. Applicants respectfully traverse the rejection.

Claim 1 has been amended to clarify the invention. In particular, claim 1 has been amended to include the limitations of canceled claims 4 and 7 as follows:

attaching a tag representing a default attention level when an attention level is not specified for an address; and
displaying for each recipient said text message with an attention level indication in response to the tag associated with the recipient's address and with said specific portion highlighted for said recipient having said specific address,
wherein said step of attaching said tag to said specific address for identifying said highlighted portion of text further comprises displaying a table of said addresses following highlighting of said text; and
selecting said address from said table which is to receive said tag identifying said highlighted portion.

Support for the amendment is provided at least by previously presented claims 4 and 7. Therefore, it is respectfully submitted that the amended claim 1 clearly raises no question of new matter and requires no additional search since both claims 4 and 7 (i.e., previously dependent on and now incorporated in amended claim 1) were previously presented for examination.

Fukumoto et al. discloses an E-mail system and E-mail transmission method of broadcasting where, when transmitting a broadcasting E-mail, a sender designates a transmission destination of an emphasized part for each item.¹ In particular, Fukumoto et al. discloses the transmitting client **11** instructs the mail server **12** to *transmit to each receiver* the E-mail that is prepared by *emphasizing and highlighting a transmission document* for each receiver.²

Further, Fukumoto et al. discloses *the mail server 12 allocates the transmission documents to the respective destinations, emphasizes and highlights the related part for each destination*, and stores the documents in the mailbox **14** of the mail server **12** (emphasis added).³ Furthermore, Fukumoto et al. discloses *the transmission document is transmitted to the receiving client 13 corresponding to the destination* (emphasis added).⁴ Moreover, Fukumoto et al. discloses the screen of each receiving client **13**, the part related to the receiver in the transmission document is emphasized and displayed with a designated highlighting method.⁵

However, Fukumoto et al. nowhere discloses, as recited in amended claim 1:

attaching a tag representing a default attention level when an attention level is not specified for an address; and
displaying for each recipient said text message with an attention level indication in response to the tag associated with the recipients address and with said specific portion highlighted for said recipient having said specific address,
wherein said step of attaching said tag to said specific address for identifying said highlighted portion of text further comprises displaying a table of said addresses following highlighting of said text; and
selecting said address from said table which is to receive said tag identifying said highlighted portion (emphasis added).

That is, Fukumoto et al. does not disclose the limitations of original claims 4 and 7 (i.e., see emphasized portion above), as recited in amended claim 1. In fact, the outstanding Office Action explicitly acknowledges at page 4, paragraph 16, that Fukumoto et al.: “does not specifically

¹ Fukumoto et al. at ABSTRACT.

² *Id.* at FIG. 2; and page 2, paragraph 47, lines 4-7.

³ *Id.* at FIG. 2; and page 2, paragraph 48, lines 1-4.

⁴ *Id.* at FIG. 2; and page 2, paragraph 48, lines 4-6.

⁵ *Id.* at FIG. 2; and page 2, paragraph 48, lines 6-9.

teach” the above-emphasized limitation of claim 4 which is now incorporated in claim 1. Moreover, the outstanding Office Action nowhere explicitly cites references from Fukumoto et al. that disclose the limitations of claim 7 which is incorporated in amended claim 1. Therefore, it is respectfully submitted that Fukumoto et al. does not disclose the invention of amended claim 1.

In addition, it is respectfully submitted that the outstanding Office Action nowhere explicitly cites any reference and Fukumoto et al. nowhere discloses: “determining from a tag inserted in an address field of said message whether any portion of said message is highlighted,” as recited in claim 9, “displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee,” as recited in claims 11 and 15; and “determining from a tag inserted in a field of said message whether any portion of said message is highlighted,” as recited in claim 17. In view of the above, Applicants submit that there is clearly no teaching in Fukumoto et al. directed at identifying a “specific highlighted portion for each recipient,” as recited in the of the invention. Therefore, it is respectfully submitted that Fukumoto et al. does not disclose the claimed invention of the above-referenced claims.

In addition, as noted above, the outstanding Office Action acknowledges deficiencies in Fukumoto et al. and attempts to overcome these deficiencies with Rochkind.⁶ However, Rochkind cannot overcome all of the deficiencies of Fukumoto et al., as discussed below.

Rochkind discloses a method and apparatus that provides personalized mailbox filters where the electronic mailbox filters or sorts messages according to personalized or customized rules set by the owner of the mailbox through the use of address extensions.⁷ In particular, Rochkind discloses predetermined address extensions and their corresponding message tags

⁶ Outstanding Office Action, paragraphs 11, 17 and 19.

⁷ Rochkind at ABSTRACT.

which indicate message play back priority.⁸ Further Rochkind discloses a system that could specify default message tags, such as urgent, important, normal, etc.⁹

However, Rochkind does not disclose, as recited in amended claim 1:

attaching a tag representing a default attention level when an attention level is not specified for an address; and
displaying for each recipient said text message with an attention level indication in response to the tag associated with the recipients address and with said specific portion highlighted for said recipient having said specific address,
wherein said step of attaching said tag to said specific address for identifying said highlighted portion of text further comprises displaying a table of said addresses following highlighting of said text; and
selecting said address from said table which is to receive said tag identifying said highlighted portion (emphasis added).

That is, Rochkind does not disclose the limitations of claim 7 (i.e., see emphasized portion above), as recited in amended claim 1. In fact, the outstanding Office Action nowhere explicitly cites a reference in either Fukumoto et al. nor Rochkind that addresses the limitations of claim 7, which has been incorporated in amended claim 1 (i.e., see emphasized portion above). Therefore, it is respectfully submitted that Fukumoto et al. does not disclose the claimed invention.

In addition, it is respectfully submitted that the outstanding Office Action nowhere explicitly cites any reference and Rochkind nowhere discloses “determining from a tag inserted in an address field of said message whether any portion of said message is highlighted,” as recited in claim 9, “displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee,” as recited in claims 11 and 15; and “determining from a tag inserted in a field of said message whether any portion of said message is highlighted,” as recited in claim 17. Thus, for the reasons cited above, Rochkind cannot cure all of the deficiencies of Fukumoto et al.

⁸ *Id.* at column 6, lines 9-11.

⁹ *Id.* at column 6, lines 36-37.

Therefore, it is respectfully submitted that neither Fukumoto et al. nor Rochkind, whether taken alone or in combination, disclose, suggest or make obvious the claimed invention and thus, claims 1, 9, 11, 15, and 17, and claims dependent thereon, patentably distinguish thereover.

In addition, as discussed above, Fukumoto et al. discloses the transmitting client **11** instructs the mail server **12** to *transmit to each receiver* the E-mail that is prepared by *emphasizing and highlighting a transmission document* for each receiver.¹⁰ Further, Fukumoto et al. discloses *the mail server 12 allocates the transmission documents to the respective destinations, emphasizes and highlights the related part for each destination*, and stores the documents in the mailbox **14** of the mail server **12** (emphasis added).¹¹ Furthermore, Fukumoto et al. discloses *the transmission document is transmitted to the receiving client 13 corresponding to the destination* (emphasis added).¹² Thus, Fukumoto et al. nowhere discloses, as claim 20 recites: “wherein the displaying and the decoding *are executed on electronic mail terminals of the recipients*” (emphasis). That is, in contrast to claim 20, Fukumoto et al. discloses highlighting at the mail server **12** before transmitting to receiving clients **13**.

Further, Rochkind cannot overcome the deficiencies of Fukumoto et al. since it nowhere discloses “displaying and the decoding *are executed on electronic mail terminals of the recipients*” (emphasis added). Therefore, it is respectfully submitted that neither Fukumoto et al. nor Rochkind, whether taken alone or in combination, disclose, suggest or make obvious the claimed invention and that claim 20, patentably distinguish thereover.

¹⁰ *Id.* at FIG. 2; and page 2, paragraph 47, lines 4-7.

¹¹ *Id.* at FIG. 2; and page 2, paragraph 48, lines 1-4.

¹² *Id.* at FIG. 2; and page 2, paragraph 48, lines 4-6.

Conclusions

In view of the foregoing, favorable reconsideration is believed to be in order. If a fee is due, please charge our Deposit Account No. 09-0458, under Order No. 20136-00324-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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